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EXAMINER
HUERTA, ALEXANDER Q

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *11 May 2009*.
2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3 and 6-13* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1,3 and 6-13* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on *10 August 2006* is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
     a) ☒ All   b) ☐ Some *   c) ☐ None of:
        1. ☒ Certified copies of the priority documents have been received.
        2. ☐ Certified copies of the priority documents have been received in Application No. _____.
        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
     Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 6-13 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim **13** is drawn to computer-readable medium for causing a computer to execute said steps in the content reproduction method of claim 12. Normally, the claim would be statutory. However, the specification, at page **6**, paragraph **[0024]** defines the claimed computer readable medium as encompassing statutory media such as a "ROM", "hard drive", "optical drive", etc, as well as *non-statutory* subject mater such as a "signal, carrier wave or other transport mechanism."

"A transitory, propagating signal … is not a "process, machine, manufacture, or composition of matter." Those four categories define the explicit scope and reach of subject matter patentable under 35 U.S.C. § 101; thus, such a signal cannot be patentable subject matter." (*In re Petrus A.C.M. Nuijten;* Fed Cir, 2006-1371, 9/20/2007).

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to *include* the disclosed tangible computer readable media, while at the same time *excluding* the intangible media such as signals, carrier waves, etc. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 3, 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant et al. (US Pat. **7,318,774**) in view of Rowe (US Pub. **2005/0124407**), herein referenced as Bryant and Rowe, respectively.

Regarding **claim 1**, Bryant discloses "a content reproduction terminal (game console 50) for reproducing content, the content reproduction terminal comprising: a terminal body (game console case); and a secure device (smartcard) to be placed in said terminal body, wherein said secure device includes: a membership information hold unit operable to hold membership information which is distributed to a membership user and indicates a group to which the user belongs" (Col. 2 lines 1-18, Col. 4 lines 22-39, i.e. the membership information is stored within the smartcard, Fig. 3), and

"said terminal body includes: an operation mode setting unit operable to set an operation mode on the basis of the membership information held by said membership information hold unit (Col. 2 lines 1-29, i.e. when the membership card is inserted into the card reader the console will determiner if the user is a member. If the user is a member then the console will operate in the second members-only mode); and a reproduction unit (controller 30) operable to reproduce the content differently depending on a setting result given by said operation mode setting unit" (Col. 4 lines 9-21)

"the second application program being different from the first application program; a selection unit operable to select one of the first application program (second mode available only to members) and the second application program (first mode available to all players) which are stored in said first storage unit and said second storage unit, respectively, in accordance with the setting result (Col. 2 lines 1-29, Col. 5 lines 31-50, i.e. a test is performed to determine if the member card has been inserted. If the result is yes, then the game will feature a second mode available only to members); and an execution unit (control processor 31) operable to execute the application program selected by the selection unit to reproduce the content (Col. 4 lines 9-21), wherein the first application program is operable to cause said execution unit to execute a members-only decorative display." (Col. 1 line 46-Col. 2 line 29, Col. 5 lines 4-13).

Bryant discloses a first and second application program for reproducing content in a member-only mode and non-member mode, respectively, however fails to explicitly disclose that "said reproduction unit includes a first storage unit operable to previously

store a first application program for reproducing the content...a second storage unit

operable to previously store a second application program for reproducing the

content..."

Rowe discloses that "said reproduction unit includes a first storage unit operable

to previously store a first application program for reproducing the content...a second

storage unit operable to previously store a second application program for reproducing

the content..." ([0014], [0054], [0093]-[0094], Fig. 3, i.e. game component information

can be stored in RAM, hard drive 320, non-volatile memory 335). Thus, it would have

been obvious to one of ordinary skill in the art to apply the technique of including a first

and second storage unit to store a first and second application program as taught by

Rowe, to improve the game machine-membership reward system of Bryant for the

predictable result of enabling the master game controller to retrieve and execute stored

application programs.

Regarding **claim 3**, Bryant discloses that "the first application program is further

operable to cause said execution unit to execute a members-only graphical user

interface display." (Col. 1 line 46-Col. 2 line 29, Col. 5 lines 4-13, Figs. 5-6).

Regarding **claim 6**, Bryant discloses "a content reproduction terminal (game

console 50) for reproducing content, the content reproduction terminal comprising: a

terminal body (game console case); and a secure device (smartcard) to be placed in

said terminal body, wherein said secure device includes: a membership information hold

unit operable to hold membership information which is distributed to a membership user

and indicates a group to which the user belongs" (Col. 2 lines 1-18, Col. 4 lines 22-39, i.e. the membership information is stored within the smartcard, Fig. 3)…, and

"said terminal body includes: an operation mode setting unit operable to set an operation mode on the basis of the membership information held by said membership information hold unit (Col. 2 lines 1-29, i.e. when the membership card is inserted into the card reader the console will determiner if the user is a member. If the user is a member then the console will operate in the second members-only mode); and a reproduction unit (controller 30) operable to reproduce the content differently depending on a setting result given by said operation mode setting unit" (Col. 4 lines 9-21),

"… the second application program being different from the first application program; a selection unit operable to select one of the first application program (second mode available only to members) and the second application program (first mode available to all players) which are stored in said first storage unit and said second storage unit, respectively, in accordance with the setting result (Col. 2 lines 1-29, Col. 5 lines 31-50, i.e. a test is performed to determine if the member card has been inserted. If the result is yes, then the game will feature a second mode available only to members); and an execution unit (control processor 31) operable to execute the application program selected by the selection unit to reproduce the content (Col. 4 lines 9-21), wherein the first application program is operable to cause said execution unit to execute a members-only decorative display." (Col. 1 line 46-Col. 2 line 29, Col. 5 lines 4-13).

Bryant discloses a first and second application program for reproducing content

in a member-only mode and non-member mode, respectively, however fails to explicitly

disclose that "said reproduction unit includes a first storage unit operable to previously

store a first application program for reproducing the content…a second storage unit

operable to previously store a second application program for reproducing the

content…"

Rowe discloses that "said reproduction unit includes a first storage unit operable

to previously store a first application program for reproducing the content…a second

storage unit operable to previously store a second application program for reproducing

the content…" ([0014], [0054], [0093]-[0094], Fig. 3, i.e. game component information

can be stored in RAM, hard drive 320, non-volatile memory 335). Thus, it would have

been obvious to one of ordinary skill in the art to apply the technique of including a first

and second storage unit to store a first and second application program as taught by

Rowe, to improve the game machine-membership reward system of Bryant for the

predictable result of enabling the master game controller to retrieve and execute stored

application programs.

Regarding **claim 7**, the combination fails to explicitly disclose "an operation mode

inquiry unit operable to inquire of said secure device about which operation mode is to

be selected, and said secure device further includes an operation mode instruction unit

operable to, when the inquiry is received, decide the operation mode on the basis of the

membership information and to instruct said terminal body to operate in the decided

operation mode, wherein said operation mode setting unit is operable to set the

operation mode on the basis of the instruction as to the operation mode decided by the

operation mode instruction unit."

Rowe discloses "an operation mode inquiry unit operable to inquire of said

secure device about which operation mode is to be selected" ([0064], [0093]-[0094], i.e.

the game machine transmits application requests to the smart card), and

"said secure device further includes an operation mode instruction unit

(processor 110) operable to, when the inquiry is received, decide the operation mode on

the basis of the membership information and to instruct said terminal body to operate in

the decided operation mode, wherein said operation mode setting unit (I/O interface

120) is operable to set the operation mode on the basis of the instruction as to the

operation mode decided by the operation mode instruction unit." ([0014], [0025]-[0026],

[0093]-[0094], Figs. 1, 3, 6, i.e. the processor receives game application selections from

the game machine so as to instruct which game to run. In addition, the I/O interface

communicates setting instruction to the game machine). Thus, it would have been

obvious to one of ordinary skill in the art to apply the technique of including an operation

mode inquiry unit, operation mode selection unit, and an operation mode setting unit to

inquire and decide the operation mode as taught by Rowe, to improve the game

machine-membership reward system of Bryant for the predictable result of enabling the

gaming system to select the appropriate game mode when the smart card is inserted.

Regarding **claim 8**, the combination fails to explicitly disclose that "said

membership information hold unit is operable to hold a plurality of sets of membership

information, and said operation mode instruction unit is operable to, when the inquiry is

received, decide the operation mode including a set of membership information that is

to be prioritized out of the plurality of sets of membership information."

Rowe discloses that "said membership information hold unit is operable to hold a

plurality of sets of membership information ([0011], [0091], i.e. player tracking

information, loyalty points, game play history, etc.), and said operation mode instruction

unit is operable to, when the inquiry is received, decide the operation mode including a

set of membership information that is to be prioritized out of the plurality of sets of

membership information." ([0029], [0035] [0093], i.e. when the smart card is inserted

into the game machine, previous game play information is loaded initially so that any

points, money, pay tables, etc. acquired from previous games are incorporated into the

new game. Furthermore, *Merriam-Webster's* dictionary defines "priority" as something

given or meriting attention before competing alternatives, thus a user's acquired

points/pay tables are prioritized over other membership information). Thus, it would

have been obvious to one of ordinary skill in the art to apply the technique of holding a

plurality of sets of membership information and prioritizing membership information as

taught by Rowe, to improve the game machine-membership reward system of Bryant

for the predictable result of enabling the user to retain points/money/status from game

to game so they can pick-up from where they left off.

Regarding **claim 9**, the combination fails to explicitly disclose that "wherein the

inquiry includes content information regarding the content to be reproduced, and said

operation mode instruction unit is operable to, when the inquiry is received, decide the

operation mode including the set of membership information to be prioritized out of the

plurality of sets of membership information, on the basis of the content information included in the inquiry."

Rowe discloses that "wherein the inquiry includes content information regarding the content to be reproduced (i.e. the game machine requests gaming applications), and said operation mode instruction unit is operable to, when the inquiry is received, decide the operation mode including the set of membership information to be prioritized out of the plurality of sets of membership information, on the basis of the content information included in the inquiry." ([0011], [0029], [0035], [0091], [0093]). Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including content information in the inquiry and prioritizing membership information as taught by Rowe, to improve the game machine-membership reward system of Bryant for the predictable result of enabling the game machine to request the appropriate game application.

Regarding **claim 10**, Bryant discloses that "said secure device includes: a membership point storage unit operable to store a membership point value given to the user; a rule storage unit operable to store a rule as to a membership status granted to the user according to the membership point value" (Col. 1 lines 32- 42, Col. 6 lines 35- 49, i.e. the smartcard stores points accumulated by the member. The points make the player eligible for certain bonus features).

Bryant fails to explicitly disclose "said terminal body further includes: an operation mode inquiry unit operable to inquire of said secure device about which operation mode is to be selected, and said secure device includes: an operation mode instruction unit

operable to, when the inquiry is received, decide the operation mode and the

membership status on the basis of the membership information, the membership point

value, and the rule, and to instruct said terminal body as to the decided operation mode

and the decided membership status, wherein said operation mode setting unit is

operable to set the operation mode on the basis of the instruction as to the operation

mode and the membership status decided by the operation mode instruction unit."

Rowe discloses "said terminal body further includes: an operation mode inquiry

unit operable to inquire of said secure device about which operation mode is to be

selected ([0064], [0093]-[0094], i.e. the game machine transmits application requests to

the smart card) and said secure device includes: an operation mode instruction unit

operable (processor 110) to, when the inquiry is received, decide the operation mode

and the membership status on the basis of the membership information, the

membership point value, and the rule, and to instruct said terminal body as to the

decided operation mode and the decided membership status, wherein said operation

mode setting unit (I/O interface 120) is operable to set the operation mode on the basis

of the instruction as to the operation mode and the membership status decided by the

operation mode instruction unit." ([0014], [0025]-[0026], [0029]-[0031], [0093]-[0094],

Figs. 1, 3, 6, i.e. the processor receives game application selections from the game

machine so as to instruct which game to run. Based on the user's point total, the smart

card instructs the game machine to execute a bonus game. In addition, the I/O

interface communicates setting instruction to the game machine).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including an operation mode inquiry unit, operation mode selection unit, and an operation mode setting unit to inquire and decide the operation mode as taught by Rowe, to improve the game machine-membership reward system of Bryant for the predictable result of enabling the gaming system to select the appropriate game mode when the smart card is inserted.

Regarding **claim 11**, Bryant discloses that "said secure device is an IC card, said terminal body further includes an IC card slot (card reader 65) into which said IC card is to be inserted, and said operation mode setting unit is operable to set the operation mode on the basis of an insertion state of said IC card with respect to said IC card slot." (Col. 4 lines 34-39, Col. 5 lines 31-50).

Regarding **claim 12**, Bryant discloses "a content reproduction method used by a content reproduction terminal (game console 50) comprising a terminal body (game console case) …, the second application program being different from the first application program and a secure device (smartcard) to be placed in the terminal body, said method comprising: a membership information hold step of holding, in the secure device, membership information which is distributed to a membership user and indicates a group to which the user belongs (Col. 2 lines 1-18, Col. 4 lines 22-39, i.e. the membership information is stored within the smartcard, Fig. 3); an operation mode setting step of setting, in the terminal body, an operation mode on the basis of the membership information held in said membership information hold step (Col. 2 lines 1-29, i.e. when the membership card is inserted into the card reader the console will

determiner if the user is a member. If the user is a member then the console will operate in the second members-only mode); and a reproduction step of reproducing, in the terminal body, the content differently depending on a setting result of said operation mode setting step" (Col. 4 lines 9-21), wherein

"said reproduction step includes: a selection step of selecting one of the first application program and the second application program which are stored in the first storage unit and the second storage unit, respectively, in accordance with the setting result (Col. 2 lines 1-29, Col. 5 lines 31-50, i.e. a test is performed to determine if the member card has been inserted. If the result is yes, then the game will feature a second mode available only to members); and an execution step of executing the application program selected in said selection step to reproduce the content (Col. 4 lines 9-21), and wherein the first application program causes said execution step to execute a members-only decorative display." (Col. 1 line 46-Col. 2 line 29, Col. 5 lines 4-13).

Bryant discloses a first and second application program for reproducing content in a member-only mode and non-member mode, respectively, however fails to explicitly disclose that "said reproduction unit includes a first storage unit operable to previously store a first application program for reproducing the content…a second storage unit operable to previously store a second application program for reproducing the content…"

Rowe discloses that "said reproduction unit includes a first storage unit operable to previously store a first application program for reproducing the content…a second storage unit operable to previously store a second application program for reproducing

the content..." ([0014], [0054], [0093]-[0094], Fig. 3, i.e. game component information can be stored in RAM, hard drive 320, non-volatile memory 335). Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including a first and second storage unit to store a first and second application program as taught by Rowe, to improve the game machine-membership reward system of Bryant for the predictable result of enabling the master game controller to retrieve and execute stored application programs.

Regarding **claim 13**, claim 13 is interpreted and thus rejected for the reasons set forth above in the rejection of claim 12.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Q. Huerta whose telephone number is (571) 270-3582. The examiner can normally be reached on M-F(Alternate Fridays Off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

<div style="text-align:right">

Alexander Q Huerta
Examiner
Art Unit 2427

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July 21, 2009

/Scott Beliveau/
Supervisory Patent Examiner, Art Unit 2427